

REMARKS

Applicant has carefully reviewed the office action mailed July 17, 2006 and offers the following remarks. Applicant concurrently files a Declaration of inventor Samuel H. Christie, IV, and a Declaration of Benjamin S. Withrow, Assignee's outside patent Attorney who drafted the present application, under 37 C.F.R. § 1.131.

Claims 1-16 and 33 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,471,519 to Howe et al. (hereinafter "Howe") in view of U.S. Patent Application Publication No. 2004/0240641 A1 to Cohen et al. (hereinafter "Cohen"). Applicant respectfully traverses.

35 U.S.C. § 102(e) requires that the invention be "...described in (1) an application for patent, published under section 122(b), by another filed in the United States **before the invention by the applicant for patent**" (emphasis added). However, Applicant conceived of the present invention prior to the filing date of Cohen, and constructively reduced the present invention to practice through the filing of the present application. As such, Cohen does not qualify as prior art under § 102(e).

In order to establish that Cohen does not qualify as prior art under § 102(e), Applicant herein presents the Declarations of Applicant's representative, Benjamin S. Withrow, and the inventor, Samuel H. Christie, IV, under 37 C.F.R. § 1.131, illustrating conception of the present invention prior to the filing date of Cohen. Based on the Declarations, Applicant asserts that the present invention was conceived of as early as January 24, 2003, and no later than January 30, 2003. Inventor Samuel H. Christie, IV conceived of the Present Invention as early as January 24, 2004 (See Declaration of Samuel H. Christie, IV, Paragraph 4 and Appendix A (see date invention discussed inside Nortel)). On January 30, 2003, Mr. Christie completed the Invention Disclosure, which shows conception of the present invention, and submitted it to the Intellectual Property Law Department at Nortel (See Declaration of Samuel H. Christie, IV, Paragraphs 4 and 5, and Appendix A). Thus, at least by January 30, 2006, prior to the June 2, 2003, filing date of Cohen, Mr. Christie had conceived of the invention claimed in the present application.

Further, the declarations show that from a date prior to June 2, 2003 (the filing date of Cohen), diligent action was taken by Applicant's representative, Benjamin S. Withrow, the inventor, Mr. Christie, and the assignee of the present application to constructively reduce the invention to practice through the filing of the instant patent application on July 28, 2003. (See

Declaration of Benjamin S. Withrow, Paragraphs 3-14; and Declaration of Samuel H. Christie, IV, Paragraphs 6-12). In particular, the assignee of the present application sent instructions on April 7, 2003 to Benjamin S. Withrow, registered U.S. patent attorney, Registration No. 40,876, of the law firm of Withrow & Terranova, PLLC, instructing him to prepare and file a patent application for the Invention Disclosure (see Declaration of Benjamin S. Withrow, Paragraph 3, and Appendix A; see also Declaration of Samuel H. Christie, IV, Paragraph 6 and Appendix B). Mr. Withrow received instructions from Nortel to prepare and file patent applications for a number of previous Invention Disclosures prior to April 7, 2003 (Declaration of Benjamin S. Withrow, Paragraph 5). From the time of receiving the instructions from Nortel to prepare and file patent applications for a number of previous Invention Disclosures, until about July 28, 2003, Mr. Withrow worked to prepare patent applications for the number of previous Invention Disclosures in essentially a chronological, first-in-first-out fashion (Declaration of Benjamin S. Withrow, Paragraph 6). Starting on or about April 7, 2003 and continuing through July 28, 2003, Mr. Withrow diligently reviewed the Invention Disclosure, spoke with the inventor Samuel H. Christie, IV, and diligently worked to prepare a patent application claiming the invention disclosed in the Invention Disclosure (Declaration of Benjamin S. Withrow, Paragraph 7; Declaration of Samuel H. Christie, IV, Paragraph 7). This included a meeting with the inventor Mr. Christie on June 13, 2003 (Declaration of Samuel H. Christie, IV, Paragraph 7). The diligent work by Mr. Withrow resulted in a first draft of the Patent Application, which was sent to the inventor on July 2, 2003 (Declaration of Benjamin S. Withrow, Paragraph 8 and Appendix B; Declaration of Samuel H. Christie, IV, Paragraph 8 and Appendix C). The inventor Mr. Christie then reviewed the draft application and provided minor comments regarding the First Draft to Mr. Withrow on July 15, 2003 (Declaration of Benjamin S. Withrow, Paragraph 9 and Appendix C; Declaration of Samuel H. Christie, IV, Paragraph 9). On July 18, 2003, Mr. Withrow revised the Patent Application to incorporate the comments from the inventor and sent a revised Patent Application to in-house counsel at Nortel, the assignee (Declaration of Benjamin S. Withrow, Paragraph 11 and Appendix C). A copy of the revised Patent Application and the inventor declaration and assignment document was also sent to the inventor on July 18, 2003, to be signed (Declaration of Benjamin S. Withrow, Paragraph 10 and Appendix C; Declaration of Samuel H. Christie, IV, Paragraph 10). On July 28, 2003, after having received a signed inventor declaration and assignment document from the inventor, and approval from in-house

counsel at Nortel to file the Patent Application substantially as drafted in the Patent Application sent to in-house counsel on July 18, 2003, the Patent Application was filed at the U.S. Patent & Trademark Office and was assigned Application Serial Number 10/628,180 (Declaration of Benjamin S. Withrow, Paragraphs 12-14 and Appendix C; Declaration of Samuel H. Christie, IV, Paragraphs 11-12). Thus, from a date prior to June 2, 2003, the filing date of Cohen, diligent action was taken by Applicant's representative, Benjamin S. Withrow, the inventor, Mr. Christie, and the assignee of the present application to constructively reduce the invention to practice through the filing of the instant patent application on July 28, 2003.

The filing date of the Cohen reference is June 2, 2003. Based on the declarations and the above facts, Applicant respectfully submits that the date of invention for the present application was prior to June 2, 2003 and that diligent action was taken from a time period prior to June 2, 2003, through the filing of the present application to constructively reduce the invention to practice. Therefore, Cohen was not filed before the present invention by Applicant. Thus, Cohen does not qualify as prior art under 35 U.S.C. § 102(e). As such, the rejection of claims 1-16 and 33 as unpatentable over Howe in view of Cohen is improper and should be withdrawn. Applicant reserves the right to address Cohen in the future if required.

Claims 17-19 and 21-32 were nominally rejected under 35 U.S.C. § 103(a) as being unpatentable over Howe in view of U.S. Patent Application Publication No. 2004/0096046 A1 to Lektion et al. (hereinafter "Lektion"). Applicant respectfully traverses.

The Patent Office has offered no new arguments with respect to claim 17, instead rejecting claim 17 on the same grounds as in a previous Office Action (see Final Office Action mailed January 12, 2006). Thus, Applicant respectfully submits that these rejection is improper and should be withdrawn for the same reasons previously set forth by Applicant (see response filed November 3, 2005, response filed March 10, 2006, and the RCE/response to the advisory action filed April 12, 2006). As such, claim 17, as well as claims 18-19 and 21-32, which depend from claim 17, define patentable subject matter.

In addition, claims 18-19 and 21-32 were actually rejected for the same reasons set forth for claims 2-3 and 5-16, respectively (see Office Action mailed July 17, 2006, p. 11). Since claims 2-3 and 5-16 were rejected over Howe in view of Cohen, the Patent Office is using Cohen to reject claims 18-19 and 21-32 as well. Since Cohen is not available as prior art, the rejection of claims 18-19 and 21-32 is improper for this reason as well.

The present application is now in condition for allowance and such action is respectfully requested. The Examiner is encouraged to contact Applicant's representative regarding any remaining issues in an effort to expedite allowance and issuance of the present application.

Respectfully submitted,

WITHROW & TERRANOVA, P.L.L.C.

By:



John R. Witcher, III
Registration No. 39,877
P.O. Box 1287
Cary, NC 27512
Telephone: (919) 654-4520

Date: November 17, 2006
Attorney Docket: 7000-262